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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY SEARLE

Appeal 2009-005186
Application 10/726,110
Technology Center 3700

Decided: September 24, 2009

Before: WILLIAM F. PATE, III, STEFAN STAICOVICI and
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1, 3-7, 9-14, 16-23¹, 76 and 77. Claims 2, 8, 15, 24-75 and 78-105 have been withdrawn. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

Claims 1, 3-7, 9-14, 16-23 are directed to a stent, and claims 76 and 77 are directed to an apparatus for dilating or occluding a vessel. Claims 1 and 76, reproduced below, are illustrative of the claimed subject matter:

1. A stent comprising:

- a generally cylindrical stent body having proximal and distal opposing ends with a body wall having a surface extending therebetween;
- an expandable filler material uniformly bonded to a thin sheet rolled upon itself having a circumference extending around a longitudinal stent axis; and
- a barrier film for encapsulating said stent.

76. An apparatus for dilating or occluding a vessel, the apparatus comprising:

- a mechanical element that conforms to a cylindrical shape whose natural or unrestrained state is slightly larger than the intended inner diameter of the vessel following dilation, the element is restrained to a smaller

¹ Although the Examiner's Answer denominates the rejection of claims 17 and 18 as a new grounds of rejection, this rejection is not considered a new grounds of rejection, since Appellant had been given a fair opportunity to respond to this rejection. Claims 17 and 18 were indicated as rejected in both of Appellant's Briefs and on the Office Action Summary accompanying the Final Rejection mailed January 20, 2006. Although the claim numbers were not specifically mentioned in the statement of rejection in the Final Rejection, the Examiner addressed the limitations of claims 17 and 18, thus giving Appellant a fair opportunity to respond. *See* Final Rej. 3:7-8. We therefore consider the rejection of claims 17 and 18 in the Answer a correction of a typographical error and not a new grounds of rejection.

diameter to allow placement to the target site using a percutaneous catheteral procedure, in the constrained state, the element exerts an outward force that, if unrestrained, would allow the element to expand to the natural state, the element is restrained mechanically by means of materials whose properties change over time due to exposure to blood protein, serum, enzymes, or changes in pH, these materials dissolve, expand or undergo changes in their physical properties to allow the element to expand slowly to the natural state.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Smith	US 5,824,046	Oct. 20, 1998
Martin	US 6,042,605	Mar. 28, 2000
Lentz	US 6,428,571 B1	Aug. 6, 2002
Khosravi	US 6,458,152 B1	Oct. 1, 2002
Yang	US 6,517,575 B1	Feb. 11, 2003

The Examiner rejected claims 76 and 77 under 35 U.S.C. § 102(e) as being anticipated by Yang. Ans. 4.

The Examiner rejected claims 1, 4, 5, 9-14, and 16-23 under 35 U.S.C. § 103(a) as being unpatentable over Khosravi and Yang. Ans. 4.

The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Khosravi, Yang, and Martin. Ans. 7.

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Khosravi, Yang, and Lentz. Ans. 7.

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Khosravi, Yang and Smith. Ans. 8.

FINDINGS OF FACT

1. Khosravi discloses a stent 20, 35 having a coiled sheet portion 21 (“a generally cylindrical body”). The sheet 21 has expandable graft material 22 (“an expandable filler material”) uniformly bonded thereto. Col. 5, ll. 28-31; col 9, ll. 5-6; figs. 1-3.
2. Khosravi employs outer sheath 44 (“a barrier film”) to maintain the stent 35 in a contracted configuration prior to deployment. Col. 9, ll. 23-36; fig. 5A.
3. Khosravi employs a mechanical expander 45 to expand and deploy the stent 35 in the body lumen 200. Col. 9, ll. 37-40.
4. Khosravi fails to disclose an expandable filler material uniformly bonded to a thin sheet.
5. Yang teaches that a non-water absorbable material 10 (“a thin sheet” or “mechanical element”) may be bonded to a water absorbable material 12 (“an expandable filler material” or “materials whose properties change over time”) and rolled into a tube 21 in order to form a self-expanding 26 or self-contracting 22 stent. Col. 2, ll. 38-58; col. 4, ll. 6-47; fig. 2.
6. Yang teaches that it is known in the art to provide a removable sheath about a stent prior to delivery. Col. 4, ll. 54-63.
7. Yang expressly suggests that more than two layers may be employed. Col. 5, ll. 8-11.

ANALYSIS

Appellant argues the rejected claims 76 and 77 as a group. App. Br. 11-18. We select claim 76 as the representative claim, and claim 77 stands or falls with claim 76. 37 C.F.R. § 41.37(c)(1)(vii)(2007). Appellant

contends that the Examiner erred by determining that claim 76 is anticipated by Yang, because the Yang device does not operate in the same fashion as the present invention to perform an identical function. App. Br. 12.

Appellant notes the differences between the embodiment described in Appellant's Specification and Yang's device, and contends that Yang's device could not be used for occlusion in the same manner as Appellant's device. App. Br. 12-18; Reply Br 2-3.

The claims, not the Specification, must define the invention in such a way as to distinguish it from the prior art. *In re Vamco Machine and Tool, Inc.*, 752 F.2d 1564, 1577 n. 5 (Fed. Cir. 1985). Where Appellant's remarks do not point to any specific language within the claims to distinguish over the prior art, those remarks amount to a general allegation that the claims define a patentable invention. App. Br. 12-18. Such allegations will not be considered an argument for separate patentability. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

A claim is anticipated if each and every element as set forth in the *claim* is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure

rather than function. *See e.g., In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997).

Yang discloses each and every limitation of claim 76. Fact 5. Claim 76 is directed to an apparatus for dilating *or* occluding a vessel. Dilation is again mentioned in the body of the claim and Appellant does not point to any language within the claim that indicates that the claimed apparatus' use is confined to occlusion. Ans. 8-10. The fact that the mechanical element may expand to a natural or unrestrained state that is slightly larger than the intended diameter of the vessel does not mandate occlusion as Appellant suggests, since the materials that mechanically restrain the element may also dissolve or expand, thereby resulting in dilation and not necessarily occlusion. App. Br. 17. Furthermore, Appellant's alternative language indicates that the claimed apparatus need not be used only for occluding but may also be used for dilating—a function which Appellant does not dispute that Yang's device is capable of performing. Ans. 8, 10. Appellant has therefore not established that the Examiner erred by determining that Yang discloses each and every element of claim 76 or that Yang would be incapable of performing the recited function of “dilating or occluding.”

Appellant argues the rejected claims 1, 4, 5, 9-14, 16 and 19-23 as a group. App. Br. 18-21. We select claim 1 as the representative claim, and claims 4, 5, 9-14, 16 and 19-23 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii). Since no separate arguments are presented regarding the rejection of claims 17 and 18, these claims will also stand or fall with claim 1. Appellant contends that the usage of the Khosravi device differs from the usage of the device described by Appellant. App. Br. 20. Appellant reiterates the arguments set forth regarding the rejection under 35 U.S.C. § 102(e) as

being anticipated by Yang, specifically noting that the purpose of the water absorbing material in Yang is for deployment only; occlusion of the vessel does not occur in Yang and Yang employs a moisture absorbing material having different properties than Appellant. App. Br. 21.

Khosravi discloses the basic structure of claim 1, however, Khosravi employs a mechanical expander to expand and deploy the stent. Facts 1-4. Yang teaches using a device that will self-expand upon exposure to water within the body. Fact 5. Yang suggests using the disclosed device with additional layers and/or an outer sheath material. Facts 6-7. Using Yang's self expanding device in place of the mechanical expander of Khosravi amounts to the simple substitution of known elements with predictable results. Such substitution would also predictably improve Khosravi's device by eliminating the need for a mechanical expander. Ans. 5-6. Thus, the subject matter of claim 1 involves no more than the predictable use of prior-art elements according to their established functions and would have been obvious to one having ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). Appellant has not addressed the rationale set forth by the Examiner for concluding that the subject matter of claim 1 would have been obvious to one having ordinary skill in the art. Ans. 5-6. Appellant is required to specifically point out the supposed errors in the Examiner's action. *See* 37 CFR 1.111(b). While Appellant discusses Khosravi and Yang individually (App. Br. 20-21), nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. Ans. 10; *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Furthermore, regarding Appellant's discussion of Yang, as noted above, it is the claims that must distinguish the invention from the prior art, and claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Arguing differences that do not appear in the claims or that the prior art has a different intended use or functions in a different way does not, without more, distinguish the claimed invention from the prior art. Ans. 10-11. In the Reply Brief, Appellant makes broad allegations that Yang teaches away from the present invention (Reply Br. 4), the combination of Khosravi and Yang would not yield a workable system (Reply Br. 5), and Khosravi involves a differing technology (Reply Br. 6). However, Appellant does not provide any further support for any of these allegations. Again, where an Appellant's remarks do not point to any specific language within the claims to distinguish over the prior art, those remarks amount to a general allegation that the claims define a patentable invention. App. Br. 20-27; Reply Br 4-7. Such allegations will not be considered an argument for separate patentability. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Regarding the rejections of claims 3, 6 and 7, the Examiner has relied upon Martin, Lentz, and Smith, respectively, to demonstrate that it would have been obvious to incorporate the claimed materials into the device taught by Khosravi and Yang. While Appellant discusses the differences between the devices disclosed in Martin, Lentz, and Smith, and the device described by Appellant, Appellant does not dispute the Examiner's findings related to these references. App. Br. 21-27; Ans. 7-8. Accordingly, Appellant has not established that the Examiner erred in concluding that the

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subject matter of claims 3, 6 and 7 would have been obvious to one having ordinary skill in the art.

CONCLUSIONS OF LAW

Appellant has not established that the Examiner erred by determining that claim 76 is anticipated by Yang. Appellant has not established that the Examiner erred in concluding that the subject matter of claim 1 would have been obvious over Khosravi and Yang. Appellant has not established that the Examiner erred in concluding that the subject matter of claims 3, 6 and 7 would have been obvious to one having ordinary skill in the art.

DECISION

For the above reasons, the Examiner's rejections of claims 1, 3-7, 9-14, 16-23, 76 and 77 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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